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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,221	04/23/2001	Hiroshi Kitada	202305US2X	4740
22850	7590	09/23/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			YUSSUF, SAJID	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/839,221

Applicant(s)

KITADA ET AL.

Examiner

Sajid A Yussuf

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2001 and 30 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/19/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

- a. A person shall be entitled to a patent unless –
 - b. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from

an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. ***Claim(s) 1-54 is/are rejected under 35 U.S.C. 102(e) as being anticipated by Parry et al. (US Patent Application No. 2002/0178213 and Parry hereinafter).***

5. As per claim(s) 1, 24, 46 Parry discloses requesting a transfer of an ASP document at an ASP user device connected to a remote document manager and a remote ASP via a network; (See Figure 1 & Abstract) establishing a predetermined time for effecting a transfer of said ASP document; and transferring said ASP document at a predetermined time (i.e., spider) via said network, (See Paragraph(s) 0100-0103 & Figure 8).

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6. As per claim(s) 2, 25 Parry teaches the claimed invention as described in claim(s) 1, 24 above and furthermore discloses sending a deferred transfer request to said remote document manager via said network when the ASP user device logs on to said remote document manager, (See Paragraph(s) 0034-0036).

7. As per claim(s) 3, 26, 47 Parry teaches the claimed invention as described in claim(s) 1-2, 24-25, 46 above and furthermore discloses logging on to said remote document manager by the ASP user device, (See Paragraph(s) 0076-0082) wherein said step of requesting a transfer comprises inputting a deferred transfer option from a menu received from said remote document manager via said network after said user device logs on to said remote document manager, (See Paragraph(s) 0076-0082).

8. As per claim(s) 4, 27 Parry teaches the claimed invention as described in claim(s) 1-3, 24-26 above and furthermore discloses inputting said predetermined time; and sending said predetermined time to said remote document manager via said network, (See Paragraph(s) 0100-0103 & Figure 8).

9. As per claim(s) 5, 28 Parry teaches the claimed invention as described in claim(s) 1-4, 24-27 above and furthermore discloses establishing a predetermined time for effecting a transfer of said ASP document comprises requesting said remote document manager to establish said predetermined time without sending a predetermined time to said remote document manager, (See Paragraph(s) 0099-0104 & Figure 8).

10. As per claim(s) 6, 29 Parry teaches the claimed invention as described in claim(s) 1-5, 24-28 above and furthermore discloses transferring said ASP document at a predetermined time via said network comprises transferring said ASP document via the Internet, (See Paragraph(s) 0100-0103 & Figure 8).

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11. As per claim(s) 7, 30, 48 Parry teaches the claimed invention as described in claim(s) 1-6, 24-29, 46-47 above and furthermore discloses determining whether said ASP document is a storage document for storing in said remote ASP or a retrieval document for retrieving from said remote ASP, (See Paragraph(s) 0037-0042).

12. As per claim(s) 8, 31, 49 Parry teaches the claimed invention as described in claim(s) 1-7, 24-30, 46-48 above and furthermore discloses determining that said ASP document is a storage document based on an operator input to said ASP user device, (See Paragraph(s) 0038) wherein user makes request for a web page; and inputting said storage document into said ASP user device, wherein said transferring step comprises transferring said ASP document via said network at said predetermined time, (See Paragraph(s) 0039-0044).

13. As per claim(s) 10, 33 Parry teaches the claimed invention as described in claim(s) 1-9, 24-32 above and furthermore discloses inputting said ASP document into said ASP user device comprises downloading an electronic copy of said ASP document from an external source to a memory associated with said ASP user device, (See Paragraph(s) 0051-0055).

14. As per claim(s) 11, 34 Parry teaches the claimed invention as described in claim(s) 1-10, 24-33 above and furthermore discloses transferring said ASP document via said network comprises sending said ASP document to said remote document manager at said predetermined time, (i.e., spider), (See Paragraph(s) 0100-0103).

15. As per claim(s) 12, 35 Parry teaches the claimed invention as described in claim(s) 1-11, 24-34 above and furthermore discloses transferring said ASP document via said network comprises sending said ASP document to said remote ASP at said predetermined time, (i.e., spider), (See Paragraph(s) 0100-0103).

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16. As per claim(s) 13, 36, 50 Parry teaches the claimed invention as described in claim(s) 1-12, 24-35, 46-49 above and furthermore discloses receiving a storage operation report at said ASP user device, (See Paragraph(s) 0112 & Figure 9).

17. As per claim(s) 14, 37 Parry teaches the claimed invention as described in claim(s) 1-13, 24-36 above and furthermore discloses receiving comprises receiving said storage operation report from said remote document manager, (See Paragraph(s) 0112 & Figure 9).

18. As per claim(s) 15, 38 Parry teaches the claimed invention as described in claim(s) 1-14, 24-37 above and furthermore discloses receiving said storage operation report from said remote ASP device, (See Paragraph(s) 0112 & Figure 9).

19. As per claim(s) 16, 39 Parry teaches the claimed invention as described in claim(s) 1-15, 24-38 above and furthermore discloses clearing said ASP document from a memory of said ASP user. Examiner takes Official Notice (see MPEP 2144.03) that the purpose of clearing any type of document in a computer networking environment were well known in the art at the time the invention was made. Specifically, clearing a "document" from memory is similar to deleting a file from a computer or simply flushing cookies from a user's temporary directory wherein in all such types of erasures are known as clearing a document from a memory.

20. As per claim(s) 17, 40 Parry teaches the claimed invention as described in claim(s) 1-16, 24-39 above and furthermore discloses determining that said ASP document is a retrieval document based on an operator input to said ASP user device, (See Paragraph(s) 0037-0044); generating a document retrieval request in said ASP user device, (See Paragraph(s) 0037-0044); sending said document retrieval request to said remote document manager via said network, (See Paragraph(s) 0037-0044); and receiving said retrieval document at said predetermined time, (See Paragraph(s) 0037-0044).

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21. As per claim(s) 18, 41 Parry teaches the claimed invention as described in claim(s) 1-17, 24-40 above and furthermore discloses receiving said retrieval document comprises receiving said retrieval document from said remote document manager at said predetermined time, (See Paragraph(s) 0100-0103 & Figure 8).

22. As per claim(s) 19, 42 Parry teaches the claimed invention as described in claim(s) 1-18, 24-41 above and furthermore discloses receiving said retrieval document comprises receiving said retrieval document from said remote ASP at said predetermined time, (See Paragraph(s) 0100-0103 & Figure 8).

23. As per claim(s) 20, 43, 52 Parry teaches the claimed invention as described in claim(s) 1-19, 24-42, 46-51 above and furthermore discloses generating a document retrieval result report, (See Paragraph(s) 0112 & Figure 9).

24. As per claim(s) 21, 44, 53 Parry teaches the claimed invention as described in claim(s) 1-20, 24-43, 46-52 above and furthermore discloses sending said document retrieval result report to said remote document manager via said network, (See Paragraph(s) 0112 & Figure 9).

25. As per claim(s) 22, 45, 54 Parry teaches the claimed invention as described in claim(s) 1-21, 24-44, 46-53 above and furthermore discloses sending said document retrieval result report to said remote ASP manager via said network, (See Paragraph(s) 0112 & Figure 9).

26. As per claim(s) 23 Parry teaches the claimed invention as described in claim(s) 1-22 above and furthermore discloses a computer readable medium containing program

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instructions for execution on a computer system, which when executed by the computer system, , (See Paragraph(s) 0023-0026, References cited for claims 1-22 above)

Claim Rejections - 35 USC § 103

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

c. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- d. Determining the scope and contents of the prior art.
- e. Ascertaining the differences between the prior art and the claims at issue.
- f. Resolving the level of ordinary skill in the pertinent art.
- g. Considering objective evidence present in the application indicating obviousness or nonobviousness.

29. Claim(s) 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry et al. (US Patent Application No. 2002/0178213 and Parry hereinafter) in view of Courtney et al. (US Patent No. 5,519,786 and Courtney hereinafter).

30. As per claim 9 Parry discloses the claimed invention as described above.

However, Parry does not explicitly teach optically scanning a paper copy of said ASP document to provide a digital signal representative of said paper copy of said ASP document; and storing said digital signal in a memory associated with said ASP user device.

Courtney teaches optically scanning a paper copy of said ASP document to provide a digital signal representative of said paper copy of said ASP document; and storing said digital signal in a memory associated with said ASP user device (See Column 2 Lines 62-67 & Column 3 Lines 1-27).

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Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Parry with the teachings of Courtney to include optically scanning a paper copy of said ASP document to provide a digital signal representative of said paper copy of said ASP document; and storing said digital signal in a memory associated with said ASP user device with the motivation to provide for useful and necessary means to transform data appearing in a hard-copy format to a format readable by and useful to computers, (See Courtney Column 1 Lines 18-25).

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

h. Becker et al. (US Patent No. 6,658,452) discloses schemes for selecting and passing an application for an application provider to an application service provider;

i. Smith et al. (US Patent No. 6,385,655) discloses method and apparatus for delivering document sever an electronic network; and

j. ~~Davis et al. (US Patent No. 6,615,233) discloses apparatus and method for~~
transmitting documents between a server computer and a client computer;


32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sajid A. Yussuf whose telephone number is (703) 305-8752. The examiner can normally be reached on Monday-Thursday 7:30-5:00 PM and Alternate Fridays.

33. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sajid Yussuf
Patent Examiner
Technology center 2100
13 September 2004


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER